

Notice of Allowability

Application No.

10/008,278

Applicant(s)

FINKELSTEIN ET AL.

Examiner

Art Unit

Jeanine A. Goldberg

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 5/31/05; 7/22/05.
2. ☒ The allowed claim(s) is/are 18-46.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date 7/05
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

J. Goldberg
JEANINE A. GOLDBERG
PRIMARY EXAMINER
8/24/05

DETAILED ACTION

1. This action is in response to the papers filed May 31, 2005 and July 22, 2005.
Currently, claims 18-46 are pending.

REASONS FOR ALLOWANCE

2. The following is an examiner's statement of reasons for allowance.

The claims are drawn to a method of topographic genotyping by analyzing a specimen under a microscope, choosing a microscopic sized target, separating target from specimen, extracting DNA not including DNA precipitation, centrifugation, removing supernatant and amplifying DNA to detect mutations.

The prior art fails to disclose or motivate the ordinary artisan to perform the instant combination of steps in a single method at the time the invention was made. As noted in the response filed July 22, 2005 and the declaration filed by Dr. Finkelstein on July 22, 2005, the combination of separate methods taught in the art would not have been obvious at the time the invention was made. The response discusses the inability to obtain the claimed invention as a whole given the teachings of the references and the uncombinability of the references. As pointed out on page 3 of the response, BenEzra uses fixed cells whereas McKenzie uses fresh cells. The response discusses the differences involved in the types of cells. Further, the references differ in the extraction procedures and would not have let the ordinary artisan to the claimed combination.

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The declaration filed by Dr. Finkelstein on July 22, 2005 provides discussion of the state of the art at the time the invention was made, i.e. 1994 and improvements of the claimed method. Dr. Finkelstein discusses each of the techniques used by Ben-Ezra, Shibata and McKenzie. It is clear that the methods differ in techniques and combining the methods to obtain the claimed invention would not have been obvious at the time the invention was made.

3. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Jeanine Goldberg whose telephone number is (571) 272-0743. The examiner can normally be reached Monday-Friday from 7:00 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (571) 272- 0745.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The Central Fax Number for official correspondence is (571) 273-8300.

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A handwritten signature in black ink, appearing to read "J. Goldberg". The signature is fluid and cursive, with the first letter "J" being large and stylized.

Jeanine Goldberg

Primary Examiner

August 24, 2005